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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/501,343
Filing Date: July 26, 2004
Appellant(s): REISACHER ET AL.

Harris A. Pitlick
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 14, 2006, appealing from the Office Actions mailed May 16, 2006 (the Final Rejection), and June 29, 2006 (the Advisory Action).

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The Amendment after Final Rejection filed on June 14, 2006, has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,110,266	GONZALEZ-BLANCO ET AL.	8-2000
US 6,646,023	NYSSEN	11-2003

Copending Application Serial No. 10/515,345

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

Claims 1-12 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/515,345.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to pigment preparations comprising a pigment, at least one anionic surface active agent, and at least one nonionic surface active agent, each of which are comparable to one another.

See, for example, claims 1-5 in the instant application and claim 1 of the '345 application, with respect to the anionic surface active agent.

Additionally, the respective sets of claims correspond to one another as follows: Instant Claims 6-11 correspond to claims 4-20 in the '345 application, and Instant Claim 12 corresponds to claims 2 and 3 in the '345 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

Claims 1-5, 7-10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Gonzalez-Blanco et al. (U. S. Patent No. 6,110,266).

Gonzalez-Blanco et al. teach pigment preparations comprising at least one pigment, at least one dispersant, and water. See the Abstract of Gonzalez-Blanco et al., as well as col. 1, lines 30-40.

Exemplary pigments, preferably used in an amount of 0.05 to 80% by weight, relative to the pigment preparation, are disclosed at col. 1, line 45 to col. 2, line 46 of Gonzalez-Blanco et al.

Examples of the dispersant include non-ionic and anionic compounds. Exemplary non-ionic compounds include reaction products of alkylene oxides with alkylatable compounds such as fatty alcohols and fatty amines (considered to read upon component (B) in Applicants' claims); exemplary anionic compounds include alkyl sulfates, ether sulfates, and phosphate esters (considered to read upon component (C)

in Applicants' claims, as well as the limitation "ether phosphates"). See col. 2, line 47 to col. 5, line 48 of Gonzalez-Blanco et al.

The dispersant is preferably used in an amount of 0.1 to 200% by weight, relative to the weight of pigments used. See col. 5, lines 49-51 of Gonzalez-Blanco et al.

At col. 6, line 34 to col. 7, line 12, Gonzalez-Blanco et al. disclose the feasibility in employing additional colorants, such as carbon blacks, organic coloring pigments (from the azo, diazo, polyazo, anthraquinone, and thioindigo series), etc., in the aforementioned pigment preparations. These additional colorants can be present in the pigment preparations in amounts ranging from 0 to 80% by weight, relative to the pigment preparation (col. 7, line 66 to col. 8, line 8).

The pigment preparations are prepared for use in printing inks for ink-jet printing by homogenizing the pigment with any optional colorant, at least one portion of the dispersant, and, if desired, with further additives, and optionally subjecting the resultant mixture to dry or wet crushing. See col. 8, lines 26-32 of Gonzalez-Blanco et al.

Alternative methods include introducing and homogenizing the pigment, optional water-soluble colorants, a portion of the dispersant, and water in a stirred vat, dissolver, or similar device, until a homogeneous milled suspension is obtained. See col. 8, lines 57-64 of Gonzalez-Blanco et al., as well as col. 9, lines 5-41, which discusses wet-crushing of the pigment and, if desired, colorants, as well as, in a dilution step, mixing the pigment preparation in water with any remaining amounts of dispersant, and homogenizing the resultant mixture, which is brought to the desired final pigment concentration and color strength of the preparation or printing ink. During this step, it

may be desirable to add another portion of dispersant, to avoid reagglomeration of the fine pigment particles in dilution.

In view of these teachings, Gonzales-Blanco et al. anticipate claims 1-5, 7-10, and 12.

Claim Rejections - 35 USC § 103

Claims 6 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez-Blanco et al. (U. S. Patent No. 6,110,266) in view of Nyssen (U. S. Patent No. 6,646,023).

Gonzalez-Blanco et al. is relied upon for its teachings as stated in the above 102(b) rejection. Although this references teaches pigment preparations that read upon claims 1-5, 7-10, and 12, as addressed above, this reference does not explicitly teach the claimed properties of particle size and surface area, as recited in claims 6 and 11.

Nyssen teaches pigment preparations comprising at least one organic or inorganic pigment and at least one compounds selected from, inter alia, reaction products of alkylene oxides with alkylatable compounds such as fatty alcohols). See col. 2, lines 41-50 of Nyssen; note that these components are also disclosed in Gonzalez-Blanco et al. as stated above.

The preparations of Nyssen are also disclosed as having a mean particle size of 20 to 2000 μm. See col. 2, lines 53-59 of Nyssen.

At col. 3, lines 1-65, Nyssen discusses exemplary inorganic and organic pigments; note that these pigments are also disclosed in Gonzalez-Blanco et al. at col. 6, line 34 to col. 7, line 12.

Because Nyssen discloses pigment preparations comparable to that of Gonzalez-Blanco et al., said preparations having a particle size comparable to that instantly claimed, one skilled in the art would find reasonable expectation that the pigment preparations of Gonzalez-Blanco et al. would exhibit a particle size within Applicants' claimed range, absent the showing of convincing evidence to the contrary.

With respect to the claimed surface area, one of ordinary skill in the art would also find reasonable expectation that the prior art pigment preparations would also exhibit this property, since the references teach pigment preparations containing the same components as those respectively recited in Applicants' claims, also in percentage amounts reading upon those respectively recited in Applicants' claims. Further, It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

Where the claimed and prior art compounds possess a close structural relationship and a specific significant property in common which renders the claimed

compounds obvious to one skilled in the art; they are effectively placed in the public domain and unpatentable per se, even though the applicant has discovered that they possess an additional activity. In re Mod, et al. (CCPA 1969) 408 F2d 1055, 161 U. S. P. Q. 281.

(10) Response to Argument

In response to Appellants' arguments that Gonzalez-Blanco "is drawn to a composition that is necessarily liquid", the Examiner maintains the position that Appellants' claims in their present form, in reciting the limitations "solid" and "comprising as essential constituents", do not exclude the presence of minor amounts of water or moisture. Further, although Gonzalez-Blanco et al. at col. 8, lines 8-22 disclose an exemplary pigment preparation comprising 10 to 98% water (lines 18 and 19), the lower endpoint of this percentage range is considered within the scope of Appellants' envisionment of the term "solid". Further, this reference does not explicitly disclose that Patentees' pigment preparations are either solid or liquid; the reference is generally silent as to the physical state of the pigment preparations. Although the reference may allude to "further evidence that the preparations are in liquid form", as argued by Appellants, the reference does not clearly indicate that the preparations cannot be in any other form.

In response to Appellants' arguments that Gonzalez-Blanco et al. do not disclose or suggest "to use particular combinations of nonionic and anionic dispersants, let alone those recited in the present claims and within the percentage ranges of the present

claims", it is the Examiner's position that this reference's contemplation of more than one of either nonionic or anionic dispersants does not exclude the contemplation of one (or more) of each dispersant, i.e., one nonionic dispersant, and one anionic dispersant.

The Nyssen reference is relied upon for disclosing a pigment preparation comprising components similar to that disclosed in Gonzalez-Blanco et al. Although this reference clearly discloses a "solid pigment preparation", the reference does not read upon the instant claims as well as Gonzalez-Blanco et al. (Nyssen discloses components corresponding only to Appellants' claimed components (A) and (C); whereas Gonzalez-Blanco et al. disclose components corresponding to Appellants' claimed components (A), (B), and (C)).

Motivation to combine the teachings of the Nyssen reference and of the Gonzalez-Blanco et al. reference is found not in the individually and respectively disclosed intended uses of the pigment preparations, but on what each pigment preparation contains, and the common components therebetween.

The provisional non-statutory obviousness-type double patenting rejection is maintained because, in the instant application, the percentage range for the nonionic surface-active additive is "from 10 to < 40% by weight", which overlaps the range "from 0% to < 30 % by weight" of the same additive, as recited in the copending '345 application. Also, the respective sets of claims recite the same percentage range for the amount of "at least one pigment". However, the copending '345 application recites a percentage range of "> 10 to 40% by weight" of the anionic surface-active additive, whereas the instant application recites a percentage range of "from 0.1 to 10% by

weight" of the same additive. The difference between the upper endpoint for this additive (i.e., the anionic surface-active additive) in the instant claims and the lower endpoint for said additive in the copending application is minimal, especially in view of the remaining additives' respective percentage ranges.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Patricia L. Hailey/plh
Examiner, Art Unit 1755
August 31, 2006

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